

REMARKS/ARGUMENTS

Claims 1, 3, 5-9, and 11-18 are currently pending in this application. Claim 3 has been cancelled, without prejudice or disclaimer. Claim 1 has been amended to include claim 2. Accordingly, support for the amendment to claim 1 can be found in claim 2, as originally filed. Claims 4 and 10 were previously cancelled. No new matter has been added.

Reconsideration of the application is requested in view of the following remarks.

Rejection under 35 U.S.C. § 102

The rejection of claims 1, 7, 9, 11-16 under 35 U.S.C. § 102(b) as anticipated by Hoyt et al. (EP 0409093), as evidenced by Lombardi et al. (US Patent No. 3,663,511), is respectfully traversed for reasons of record and the reasons indicated below.

Claim 1 has been amended to include claim 2, in which Hoyt et al. nor Lombardi et al. describe or suggest the unbranched alkanemonocarboxylic acid of the claimed polyamide. Therefore, withdrawal of the rejection is requested.

Rejection under 35 U.S.C. § 103

The rejection of claims 2, 3, 8 and 10 under 35 U.S.C. § 103(a) as obvious over Hoyt et al., as evidenced by Lombardi., and claims 5-6, 17-18 under 35 U.S.C. § 103(a) as obvious over Hoyt et al. in combination with Brubaker (US Patent No. 2,264,298), as evidenced by Lombardi, are respectfully traversed for reasons of record and the reasons indicated below.

As an initial matter, Applicants note the Office's assertion that the final product of claim 1 and Hoyt's polyamide are identical, and that Applicants have admitted on the record in the Response dated 6/24/08 "that the structure of polyamide, produced by Hoyt and one claimed by Applicant[,] are identical." Present Office Action at page 7 (Response to Arguments section). Applicants respectfully disagree.

In the Response dated 6/24/08, Applicants specifically pointed out that "[t]he polyamide prepared according to [Hoyt et al.] produces no water whereas the polyamide prepared in the disclosure produces water as a by-product *and [that] this water forming reaction leads to a polyamine with different physical properties including equal or higher melt volume rate* as noted

above. Therefore, the use of epsilon-caprolactone is not equivalent to 6-Hydroxycaproic acid as the office has suggested with regard to [Lombardi et al.].” (Emphasis added).

The Office also asserts in the Response to Arguments of the present Office Action that “[s]ince [a] polyamide is claimed (not a method of making or composition) the patentability [is] determined by the product itself, not the method.”

However, Applicants point out that the present application includes process and product by process claims, in which the Federal Circuit recently determined in *Abbott Laboratories v. Sandoz Inc.*, ___ F.3d ___ (Fed. Cir. 2009)(Rader, J.)(partially *en banc*)(citations omitted), the court overruled *Scripps Clinic & Research Foundation v. Genentech, Inc.* 927 F.2d 1565 (Fed. Cir. 1991)(Newman, J.), that “[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention” (quoting *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 19 (1997)).

Applicants further point out that, as the Board of Patent Appeal and Interferences (“the Board”) has recently confirmed, a proper obviousness determination requires that “the examiner bears the initial burden of presenting a prima facie case of obviousness.” *See Ex parte Martin Haubner and Rolf Pinkos*, Appeal 2009-0449, citing *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993)(overturning a final rejection by an examiner, in which the examiner failed to show that the combination of prior art suggested the claimed process). The Board has also emphasized that the Office must make “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.” *See In re Ward and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

In the present case, by comparison to the cited references of record, there are apparent physical property differences between the claimed inventions and the cited references, e.g., the reaction of the polyamide with the alkanemonocarboxylic acid generates water and this liberation of water maintains or increases the melt volume rate which is a property goal of the claimed polyamide. Further, the Office has not shown any apparent reason to modify the references to produce the same results as the claimed invention.

Therefore, the claimed invention is non-obvious over Hoyt et al. and/or Lombardi et al.. Accordingly, withdrawal of the rejection is requested.

In view of the foregoing, reconsideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 03-2775.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00072 from which the undersigned is authorized to draw.

Dated: June 10, 2009

Respectfully submitted,

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